

submits this Amendment under 37 CFR §1.111 since the present Office Action is non-final.

With respect to the rejection of Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek*, Applicant respectfully submits that this rejection is improper for the reasons that follow.

More specifically, in the Office Action, the Patent Office stated:

Petkovsek discloses in Figures 1, 2 and 6, a mailing assembly comprising a backing sheet, first and second mailing forms removably attached to the backing sheet by an adhesive and separable by a tear line wherein the forms include a first return postcard integrally formed with a designator section (24A) indicative of a special service (Col. 4, lines 29-31), having a machine readable code.

Independent Claim 1 of Applicant's invention defines a special service mailing assembly with a backing sheet and a first mailing form removably attached to the backing sheet by an adhesive. The first mailing form has a first return postcard integrally formed with a first designator section indicative of a special service. The first designator section is completely contained within first exterior sides that define the first return postcard. A second mailing form, removably attached to the first mailing form by the adhesive, has a second return postcard integrally formed with a second designator section indicative of the special

service. The second designator section is completely contained within second exterior sides that define the second return postcard.

Independent Claim 13 defines a method for preparing a mailpiece for delivery by a special service. The method comprises the steps of: providing a first return postcard having exterior sides and a first special designation section completely within exterior sides of the first return postcard. Still further, the method provides a second return postcard having exterior sides and a second special designation section wherein the second special designation section is completely within exterior sides of the second return postcard.

On the contrary, *Petkovsek* teaches a mailing assembly formed from a single sheet to provide a label and a return postcard for use in mailing an item requiring special services. The Patent Office erroneously refers to the bar code in *Petkovsek* as a designator section indicative of a special service. On the contrary, the bar code section merely aids in the tracking of the article being delivered. The bar code does NOT provide an indication of the special service as required by Claims 1 and 13 of the present invention. The tracking of an article is an entirely different function from a section indicating a special service designation. Therefore, *Petkovsek* does not teach or suggest a designator section indicative of a special service as required by Claims 1 and 13 of the present invention.

It is submitted that the question under 35 U.S.C. §103(a) is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's label and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Petkovsek* to produce the

claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 1-15 under 35 U.S.C. §103, in view of *Petkovsek*, is improper and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 as being unpatentable over *Walz* in view of *Popat et al.*, Applicant respectfully submits that this rejection is also improper for the reasons that follow.

More specifically, in the Office Action, the Patent Office stated:

Walz discloses in Fig. 1, 4 and 5, an assembly comprising a first form having a first postcard (70), a first anchor portion and a removably attached to the postcard via a tear line, wherein the first anchor has adhesive on the backside of the anchor, a first backing strip received over the adhesive on the anchor portion's backside, an integrally formed designator section indicative of special services, an area contained within the postcard printed with machine readable code, and a second form removably attached to the first form by a tear line.

Still further, the Patent Office stated:

Popat et al. discloses in Figure 10, an assembly comprising a first form and a second form, wherein a tear line is arranged to separate the first form from the second form. Therefore it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify *Walz's* assembly to include multiple form assembly connected by a tear line as taught by *Popat et al.* for the purpose of printing multiple areas of a sheet without disposing extra unused paper area and for providing conveniency for anyone using an advanced printer.

Independent Claim 16 requires a mailing assembly for preparing a mailpiece for delivery by a special service. The mailing assembly has a first anchor portion having a backside and a first return postcard having a backside. The backside of the first anchor portion has an adhesive and the backside of the first return postcard has no adhesive. Additionally, Claim 16 requires a second mailing form having an anchor portion having a backside and a second return postcard having a backside. An adhesive is present on the backside of the second anchor portion, and no adhesive is present on the backside of the second return postcard.

Neither *Walz* nor *Popat et al.*, taken singly or in combination, teach or suggest a mailing assembly for preparing a mailpiece for delivery by a special service with a first return postcard and a second return postcard wherein the return postcards do not have an adhesive backside.

Popat et al. teach a method for preparing and printing adhesively-backed notes. Further, *Popat et al.* teach a mailing assembly wherein a first form and a second form are

separated by a tear line. More specifically, *Popat et al.* teach multiple adhesive notes attached together via a perforation line.

Walz teaches a multi-part mailing form with various labels that may be peeled or detached from the mailing form. Various mailing indicia may be imprinted on the various forms for use during the mailing process. A return postcard for confirming receipt of a mailed item is included in the forms and labels provided by *Walz*.

However, *Walz* does not teach or suggest a return postcard having a non-adhesive backside. On the contrary, the postcard area of *Walz* is adhesively attached to the lower sheet. More specifically, in column 3, lines 38-40, *Walz* specifically states "Thus, the upper and lower sheets adhere together permanently in all regions of the lower sheet which are not treated with non-adhesive material." Because the backside of the return postcard in *Walz* is not treated with a non-adhesive material, the backside of the return postcard in *Walz* has an adhesive.

Clearly, *Walz* does not teach or suggest a return postcard without an adhesive on the backside. On the contrary, *Walz* discloses exactly the opposite. A non-adhesive backside of a postcard, as defined in Claim 16 of Applicant's invention,

allows the postcard to be separated from a backing layer and mailed without the postcard attaching to unwanted surfaces.

Because neither Walz nor Popat et al. disclose the features defined in Claim 16 of Applicant's invention, the rejection of Claim 16 under 35 U.S.C. §103(a) is improper.

Further, it is submitted that the question under 35 U.S.C. §103(a) is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's label and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect*

Planning Corp. v. Feil, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

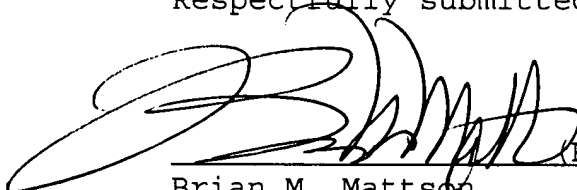
With the analysis of the deficiencies of *Walz* and *Popat et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Accordingly, the rejection of Claims 1-20 under 35 U.S.C. §103 is improper and should be withdrawn. Notice to that effect is requested.

Claims 2-12 depend from Claim 1; Claims 14 and 15 depend from Claim 13; and Claims 17-20 depend from Claim 16. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims since each sets forth additional structural elements and steps of Applicant's novel label and method, respectively.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to

issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

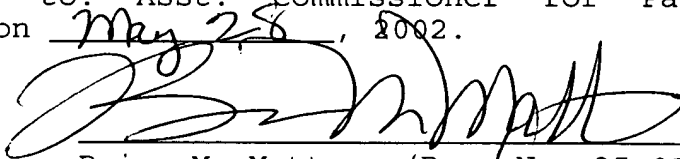


(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, Illinois 60647
Telephone: (773) 772-6009
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231 on May 28, 2002.



Brian M. Mattson (Reg. No. 35,018)